



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/323,636	06/01/1999	JAMES E. BARRY	8688.6808	9457

7590 04/17/2003

DANIEL S POLLEY ESQ
MALIN HALEY & DIMAGGIO
1936 SOUTH ANDREWS AVENUE
FORT LAUDERDALE, FL 33316

EXAMINER

LEE, Y MY QUACH

ART UNIT PAPER NUMBER

2875

DATE MAILED: 04/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/323,636

Applicant(s)

BARRY, JAMES E.

Examiner

Y Quach Lee

Art Unit

2875

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 March 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 to 23, 25, 26 and 28 to 33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1 to 16 is/are allowed.
- 6) ☒ Claim(s) 17 to 23, 25, 26 and 28 to 31 is/are rejected.
- 7) ☒ Claim(s) 32 to 33 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

Art Unit: 2875

DETAILED ACTION

Response to Amendment

1. The indicated allowability of claims 17 to 23, 25, 26, and 28 to 31 and the finality of the rejection of the last Office action are withdrawn in view of the newly rejection based upon recapture of surrendered subject matter. Rejection(s) based on the recapture of surrendered subject matter follows.

Reissue Applications

2. Claims 17 to 23, 25, 26 and 28 to 31 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue application that was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent can not be recaptured by the filing of the present reissue application. The recapture exists because the reissue claims 17, 22, 26, 30 and 31 are broader than the patent claims 1, 8, 9, 14 and 15 by the omission of the limitation "... light which illuminates the side and front ground areas adjacent the motorcycle". The omission of the above limitation is related to subject matter surrendered in the original application because during prosecution of the original application that this limitation distinguished original patent claims from references Carlson and Farchione and that this limitation was critical to patentability (second full paragraph on page 9 and lines 1 to 2 on page 10 of the amendment of August 19, 1996 of application serial number 08/468,931). These arguments constitute an admission by applicant that the limitation is necessary to overcome the prior art. Therefore, the reissue claims are broader than the original application claims in an aspect relevant to prior art rejection and related to the surrendered subject matter.

Art Unit: 2875

Claim Objections

3. Claims 26, 31 and 32 are objected to because of the following informalities: In claim 26, line 3, the term "an", second occurrence, is incorrect and should be changed to --a--. In claim 31, it would appear that the term "conventional" should be inserted before the term "motorcycle" on line 6 to separate the term "a motorcycle gasoline tank" on lines 5 to 6 from "a motorcycle gasoline tank" on lines 4 to 5 of the same claim. In claim 32, it would appear that the term "conventional" should be inserted before the term "motorcycle" on line 8 to separate the term "a motorcycle gasoline tank" on lines 8 to 9 from "a motorcycle gasoline tank" on line 7.

Appropriate correction is required.

4. Claims 1 to 16 are allowed.

5. Claims 32 to 33 would be allowable if rewritten to overcome the objection set forth in this Office action.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Y Quach Lee whose telephone number is 703-308-1939. The examiner can normally be reached on Tuesday and Thursday from 8:30 am to 4:30 pm.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

Y. Q.
April 8, 2003



Y Quach Lee
Patent Examiner
Art Unit 2875